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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,833	11/30/2000	Guido M. Schuster	00-421	2322
20306	7590	05/19/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			FOX, JAMAL A	
300 S. WACKER DRIVE			ART UNIT	PAPER NUMBER
32ND FLOOR			2664	
CHICAGO, IL 60606			DATE MAILED: 05/19/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/728,833	SCHUSTER ET AL.	
	Examiner	Art Unit	
	Jamal A Fox	2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 November 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 30 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-17 and 19-21</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-9, 11-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuster et al. (U.S. Patent No. 6,577,622).

The applied reference has a common --assignee-- and --inventor-- with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1, Schuster et al. discloses a system for configuring a telephone for service comprising:

a data network (Fig. 2, ref. sign 206 and respective portions of the spec.) to provide data connectivity for a plurality of data communications channels (Data Channel, Fig. 8B, ref. signs 486 and 488; and Fig. 9B ref. signs 518, 522 and 524 and respective portions of the spec.) using data transport protocol (Tiny TP, Fig. 5, ref. sign 610; and Figures 6 and 7, RTP and UDP and respective portions of the spec.);

at least one data network telephone (Fig. 2, ref. sign 208 and respective portions of the spec.) connected to the data network, the data network telephone operable to communicate voice signal as data packets on a voice over data channel (voice over data, col. 10 lines 32-36 and col. 12 lines 59-65), the voice over data channel being one of the plurality of data communications channels (Fig. 8B, ref. signs 486 and 488; and Fig. 9B ref. Signs 518, 522 and 524 and respective portions of the spec.) on the data network containing packetized voice signals, the data network telephone being operable to convert data packets communicated on the voice over data channel to voice (col. 5 lines 45-49);

a telephone configuration server (Fig. 2, ref. sign 250 and respective portions of the spec.) connected to the data network (Fig. 2, ref. sign 206 and respective portions of the spec.), the telephone configuration server comprising at least one service provider configuration (col. 2 lines 10-16) comprising at least one voice communications function (col. 2 lines 17-36); and

a telephone part number (phone numbers and 8475551212@3Com.com, col. 10 lines 10-20) comprising any combination of alphanumeric characters (alphanumeric, col. 7 lines 65-66), the telephone configuration server being operable to associate the telephone part number with a selected one of the at least one service provider configurations (col. 10 lines 14-29).

Referring to claim 2, Schuster et al. discloses the system of claim 1, wherein the service provider configuration includes a service provider proxy address (the proxy address is inherent because of the proxy servers col. 9 lines 10-16) associated with a service provider server operable to configure the data network telephone in accordance with a telephone service provider.

Referring to claim 3, Schuster et al. discloses the system of claim 2, wherein the service provider includes a network telephony connection server operable to perform registration functions, the registration functions (registration functions 247, Fig. 3 and respective portions of the spec.) being operable to enable the data network telephone to communicate on the data network.

Referring to claim 4, Schuster et al. discloses the system of claim 3, wherein the network telephony connection server uses a call management protocol (SIP, col. 8 lines 20-26) to perform registration functions.

Referring to claim 5, Schuster et al. discloses the system of claim 4 wherein the call management protocol is a protocol selected from the group consisting of: Session Initiation Protocol (SIP), H.323, MGCP and MEGACO (col. 8 lines 20-26).

Referring to claim 6, Schuster et al. discloses the system of claim 1, further comprising a telephone service mapping system (SIP REGISTER message, col. 10 lines 14-29) operable to associate the telephone part number with the service provider configuration.

Referring to claim 7, Schuster et al. discloses a telephone (Fig. 2, ref. sign 208 and respective portions of the spec.) communicating voice signals on a data network telephony system, the telephone comprising:

a network interface (Fig. 3, network interface 270 and respective portions of the spec.) to sense a network connection;

a signaling stack (signaling stack, col. 12 lines 12-34) operable to perform call initiation functions;

a media engine (Fig. 3, Media Engine 241 and respective portions of the spec.) operable to perform data communications functions, the media engine comprising a voice function operable to communicate digitized voice signals on data packets;

a telephone configuration identifier (telephone identifier, col. 7 line 64-col. 8 line 4) operable to establish a connection to a telephone configuration server comprising at least one service provider configuration; and

a telephone part number (phone numbers and 8475551212@3Com.com, col. 10 lines 10-20) comprising any combination of alphanumeric characters (alphanumeric, col. 7 lines 65-66) associated with a selected one of the at least one service provider configurations in the telephone configuration server, the data network telephone being

operable to receive the service provider configuration during the connection with the telephone configuration server (col. 10 lines 14-29).

Referring to claim 8, Schuster et al. discloses the telephone of claim 7 further comprising:

a service initialization function (session initiation services, col. 7 lines 57-60 and call initiation, col. 8 lines 56-63) operable to establish a connection to the telephone configuration server and to receive configuration information from the telephone configuration server.

Referring to claim 9, Schuster et al. discloses the telephone of claim 8 wherein the telephone receives a service provider proxy address (the proxy address is inherent because of the proxy servers col. 9 lines 10-16) from the telephone configuration server, the service provider proxy address associated with a service provider server, the telephone further comprising a register function (registration functions 247, Fig. 3 and respective portions of the spec.) to connect to the service provider server to obtain a telephone configuration.

Referring to claim 10, Schuster et al. discloses the telephone of claim 9 wherein:

The telephone includes a display device; wherein, the telephone configuration includes a service provider logo and the registration function displays the service provider logo on the display.

Referring to claim 11, Schuster et al. discloses a telephone configuration server (Fig. 2, ref. sign 250 and respective portions of the spec.) comprising:

a phone configuration database (database, col. 1 line 61-col. 2 line 5 and col. 16 lines 54-59) comprising a plurality of data network telephone part numbers (phone numbers and 8475551212@3Com.com, col. 10 lines 10-20); and

at least one service provider configuration comprising a service provider configuration comprising features in accordance with a telephone service provider, the telephone configuration server operable to communicate the service provider configuration to a data network telephone associated with a corresponding one of the plurality of telephone part numbers (col. 7 line 57-col. 8 line 4).

Referring to claim 12, Schuster et al. discloses the telephone configuration server of claim 11 wherein the service provider configuration includes a service provider proxy address (the proxy address is inherent because of the proxy servers col. 9 lines 10-16) associated with a service provider server, the telephone configuration server operable to communicate the service provider proxy address to the data network telephone.

Referring to claim 13, Schuster et al. discloses the telephone server of claim 11 further comprising a mapping function (SIP REGISTER message, col. 10 lines 14-29) operable to receive at least one telephone part number associated with at least one service provider configuration.

Referring to claim 14, Schuster et al. discloses a method of configuring a data network telephone to perform telephone service function in accordance with a telephone service provider (col. 3 lines 28-34), the method comprising the steps of:
connecting to a telephone configuration server (Fig. 2, ref. sign 250);

sending a telephone part number associated with the data network telephone to the telephone configuration server (col. 7 lines 57-62);

receiving the service provider configuration corresponding to the telephone part number (col. 7 line 63-col. 8 line 4); and

configuring the data network telephone in accordance with the service provider configuration (col. 2 lines 10-36).

Referring to claim 15, Schuster et al. discloses the method of claim 14 wherein the step of receiving the service provider configuration includes the step of receiving a service provider proxy address (the proxy address is inherent because of the proxy servers col. 9 lines 10-16).

Referring to claim 16, Schuster et al. discloses the method of claim 15 wherein the step of configuring the data network telephone includes the step of connecting to a service provider server associated with the service provider proxy address (the proxy address is inherent because of the proxy servers col. 9 lines 10-16).

Referring to claim 17, Schuster et al. discloses the method of claim 14 further comprising the step of mapping the service provider configuration to the telephone part number, the step of mapping comprising the steps of;

sending the telephone part number associated with the data network telephone to the telephone configuration server (col. 7 lines 57-62); and

sending the service provider configuration corresponding to the telephone part number to the telephone configuration server (col. 7 line 63-col. 8 line 4).

Referring to claim 19, Schuster et al. discloses a method of providing service provider selected configurations of a data network telephone from a central server, the method comprising the steps of:

receiving a telephone part number corresponding to the data network telephone (col. 7 lines 57-62);

retrieving a service provider configuration corresponding to the telephone part number from a telephone configuration database (col. 7 line 63-col. 8 line 4); and

sending the service provider configuration to the data network telephone (Fig. 2 ref. signs 209 and 230 and respective portions of the spec.).

Referring to claim 20, Schuster et al. discloses the method of claim 19 further comprising, before the step of receiving the telephone part number, the step of mapping (SIP REGISTER message, col. 10 lines 14-29) at least one telephone part number to a corresponding service provider configuration.

Referring to claim 21, Schuster et al. discloses the method of claim 20 wherein the step of mapping the telephone part number comprises the steps of:

connecting to a data network telephone (Fig. 2, ref. sign 250);

receiving a selected telephone part number corresponding to the data network telephone (col. 7 lines 57-62);

receiving a selected service provider configuration corresponding to the telephone part number (col. 7 line 63-col. 8 line 4); and

storing (storing, col. 8 lines 1-4) the selected telephone part number in correspondence with the service provider configuration.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Schuster et al.

The applied reference has a common --assignee-- and --inventor-- with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned

by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Referring to claim 10, Schuster et al. discloses the telephone of claim 9 wherein:

The telephone includes a display device (col. 11 lines 26-32); but does not explicitly teach wherein, the telephone configuration includes a service provider logo and the registration function displays the service provider logo on the display. However a registration function is disclosed (registration functions 247, Fig. 3 and respective portions of the spec.). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the telephone configuration including a service provider logo and the registration function displaying the service provider logo on the display in order to see which provider is supplying to services for the data network telephone as suggested by Schuster et al.

Referring to claim 18, Schuster et al. discloses the method of claim 17, but does not explicitly teach wherein the step of mapping is performed in a method for manufacturing the data network telephones. However Schuster et al. discloses that the data network telephones are pre-programmed (col. 10 lines 10-28). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the step of mapping being performed in a method for manufacturing the data network telephones because the data network telephones are pre-programmed as suggested by Schuster et al.

Conclusion

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-3988, (for formal communications intended for entry)

Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA. 22202, Sixth Floor (Receptionist).

**6. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Jamal A. Fox whose telephone number is (703) 305-
5741. The examiner can normally be reached on Monday-Friday 6:30 AM - 5:00 PM.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Wellington Chin can be reached on (703) 305-4366. The fax phone
numbers for the organization where this application or proceeding is assigned are (703)
872-9306 for regular communications and (703) 872-9315 for After Final
communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 306-
0377.

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J.A.F.
Jamal A. Fox

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